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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TORRES VELAZQUEZ, NORCA LIZ	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/982,342	MUTHIAH ET AL.	
	Examiner	Art Unit	
	Norca L. Torres-Velazquez	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *64,66 and 67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *64,66 and 67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed November 1, 2004 have been fully considered but they are not persuasive.

a. Claims 64, 66 and 67 are now pending. All other claims have been canceled by Applicants.

b. Applicants have amended independent claim 64 to specify that an expanded fiber is claimed, rather than a polymeric material. Applicants stated that the expanded foam of Ahmed et al. does not read on a polymer fiber.

It is noted that the now claimed "expanded polymeric fiber" has no support in the Specification or the claims as originally claimed. The original claim 65 claimed that the polymeric material comprised a fiber, which is not the same as saying that the polymeric material is a fiber. The amendment to claim 64 requiring the expanded polymeric material to be a fiber changes the scope of the invention and is not enabled by the Specification.

Further, it is noted that the Ahmed et al. reference teaches a composition comprising a thermoplastic composition and at least one super absorbent polymer (SAP). (Col. 5, lines 8-10) The reference also teaches that the composition can be extruded in the form of a fiber. (Col. 4, lines 39-43; Col. 13, lines 43-45) The reference further teaches using a chemical blowing agent in the composition to produce an open cell foam structure. (Col. 13, lines 48-61) Therefore, it is the Examiner's position that the Ahmed et al. teachings read on the presently claimed invention since the composition taught by

the reference has a SAP material incorporated in the composition and the composition can be extruded to form a fiber. With the inclusion of a chemical blowing agent in the composition as taught by Ahmed et al., then the produced fiber could have an open cell foam structure which is equated by the Examiner to the "expanded" limitation claimed herein.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 64, 66 and 67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. However, the Specification does not disclose or teach that the polymeric material is a fiber as presently claimed. Original claim 65, dependent on claim 64, claimed that the polymeric material comprises a fiber. The claim as originally presented, was claiming an absorbent product comprising an expanded polymeric material having a superabsorbent polymeric material incorporated therein, the polymeric material further comprising a fiber. The original structure claimed is not the same as the presently claimed structure. The present amendment changes the scope of the invention. Therefore, the present claimed invention is not supported by the Specification as originally filed.

4. Claims 64, 66 and 67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Specification discloses that the process of the present invention permits incorporation of superabsorbent (powder or film) into polymeric materials by treating the polymeric material with a superabsorbent material contained in supercritical fluid solvents. (Page 15, lines 11-15). However, it does not enables for the "expanded polymeric fiber" structure claimed herein.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 64, 66 and 67 are rejected under 35 U.S.C. 102(e) as being anticipated by AHMED et al. (US 6,534,572 B1).

AHMED et al. discloses a composition comprising a thermoplastic component and at least one super absorbent polymer. The composition may be formed into a film layer or applied to an article with various hot melt adhesive application techniques. The composition is useful in disposable articles. (Abstract) The reference further teaches the use of particles of SAP with particle size from about 10 to about 1000 microns. (Column 13, lines 16-22) The composition is preferably made by first preparing the thermoplastic component by melting and blending all the thermoplastic ingredients and then adding the SAP to the molten thermoplastic component. The SAP containing thermoplastic composition may be fed simultaneously at the appropriate rates into an extruder. (Column 13, lines 36-45) Ahmed et al. also teaches the use of their composition in foam structures. (Col. 13, lines 48-61) Ahmed et al. reference teaches a composition comprising a thermoplastic composition and at least one super absorbent polymer (SAP). (Col. 5, lines 8-10) The reference also teaches that the composition can be extruded in the form of a fiber. (Col. 4, lines 39-43; Col. 13, lines 43-45) The reference further teaches using a chemical blowing agent in the composition to produce an open cell foam structure. (Col. 13, lines 48-61) The reference further teaches forming a film with the composition. (Refer to claim 9) Therefore, it is the Examiner's position that the Ahmed et al. teachings read on the presently claimed invention since the composition taught by the reference has a SAP material incorporated in the composition and the composition can be extruded to form a fiber. With the

inclusion of a chemical blowing agent in the composition as taught by Ahmed et al., then the produced fiber could have an open cell foam structure which is equated by the Examiner to the "expanded" limitation claimed herein.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 64 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-38, 39, 42-43 and 57-60 of copending Application No. 10/357,907 in view of AHMED et la. (US 6,534,572 B1). The copending application claims a powder mixture comprising a thermoplastic resin powder and a SAP powder. However, it fails to teach that these are in an expanded polymeric fiber structure. Ahmed et al. reference teaches a composition comprising a thermoplastic composition and at least one super absorbent polymer (SAP). (Col. 5, lines 8-10) The reference also teaches that the composition can be extruded in the form of a fiber. (Col. 4, lines 39-43; Col. 13, lines 43-45) The composition is useful in disposable articles. (Abstract) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the powder

mixture of the copending application and provide with a fiber structure with the motivation of producing an alternative structure suitable for use in disposable articles.

This is a provisional obviousness-type double patenting rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Norca L. Torres-Velazquez
Examiner
Art Unit 1771

January 12, 2005